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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,355	02/20/2004	Sangkeun Rhee	H0004592 (4760)	7712

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09/07/2005

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EXAMINER

ZACHARIA, RAMSEY E

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/783,355

Applicant(s)

RHEE ET AL

Examiner

Ramsey Zacharia

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/20/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 36-51 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an adhesive composition comprising a styrene block copolymer, does not reasonably provide enablement for an adhesive composition comprising a styrene copolymer that is not a block copolymer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. According to the instant specification, the adhesive composition must comprise a styrenic block copolymer (e.g. see Summary of Invention; page 12, lines 9-11; page 16, line 23-page 17, line 10; and the inventive examples).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11 and 46-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claim 11, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
6. Claims 46-51 recite the limitation "said styrenic block copolymer" in the first line of each claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 36-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Ikeda et al. (EP 857,758 A1).

Ikeda et al. teach an adhesive composition comprising 50-99 parts of a hydrogenated block copolymer, 1 to 50 parts of a tackifier, and 10-1000 parts of an ethylenic polymer (page 3, lines 35-43). The hydrogenated block copolymer may be of the general formula A-B-A wherein A is styrene and B is isoprene or butadiene (page 4, lines 27-39). Hydrogenated styrene/butadiene/styrene is styrene/ethylene butylene/styrene copolymer. The tackifier may be a petroleum or a terpene resin (page 5, lines 35-37). The ethylenic polymer may be an ethylene- $\alpha$ -olefin copolymer wherein the  $\alpha$ -olefin has 3-20 carbon atoms (page 6, lines 3-10).

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9. Claims 36-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al. (JP 09-302,319 A).

Because an English language translation of JP 09-302,319 A was unavailable at the time of this action, a machine translation of JP 09-302,319 A is attached.

Sato et al. teaches an adhesive composition comprising 10-80 wt% of ethylene- $\alpha$ -olefin copolymer, 1-50 wt% of a styrene-ethylene-propylene-styrene block copolymer, and 19-60 wt% of a tackifier (abstract). The tackifier may be a petroleum resin (paragraph 0036). The  $\alpha$ -olefin has 3-30 carbon atoms (paragraph 0012). The styrene copolymer may further be a styrene-isoprene-styrene block copolymer (paragraph 0035).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-35 and 52-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. (US 2004/0197567) in view of Ikeda et al. (EP 857,758 A1).

Tsai et al. teach a coextruded multilayer film comprising a layer of fluoropolymer, layer of cyclic olefin, and an adhesive layer (paragraph 0008). The fluoropolymer may be a homopolymer or copolymer of chlorotrifluoroethylene (paragraph 0014). Additional layers (comprising polymers such as polyolefin, polyvinyl chloride, and polyvinylidene chloride) may be attached to the fluoropolymer layer or cyclic olefin layer directly or by an adhesive

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(paragraph 0018). The film may be uniaxially or biaxially oriented about 1.5 to 10 times in either/each direction and thermoformed to produce blister packs for pharmaceuticals (paragraph 0023). The film may also be formed into pouches (paragraph 0039). The film may be formed by a blown coextrusion process (paragraph 0021).

Regarding claims 35, 55, and 61, a pouch reads on a tube since a pouch is merely a tube having one end closed off.

Tsai et al. do not teach the use of an adhesive comprising a styrene block copolymer, a tackifier, and an ethylene- $\alpha$ -olefin copolymer.

Ikeda et al. teach an adhesive composition comprising 50-99 parts of a hydrogenated block copolymer, 1 to 50 parts of a tackifier, and 10-1000 parts of an ethylenic polymer (page 3, lines 35-43). The hydrogenated block copolymer may be of the general formula A-B-A wherein A is styrene and B is isoprene or butadiene (page 4, lines 27-39). Hydrogenated styrene/butadiene/styrene is styrene/ethylene butylene/styrene copolymer. The tackifier may be a petroleum or a terpene resin (page 5, lines 35-37). The ethylenic polymer may be an ethylene- $\alpha$ -olefin copolymer wherein the  $\alpha$ -olefin has 3-20 carbon atoms (page 6, lines 3-10). The adhesive may be used in film packaging materials used for foods or pharmaceutical products (page 9, lines 44-49).

It would be obvious to one skilled in the art to use the adhesive of Ikeda et al. as the adhesive for the film of Tsai et al. because Ikeda et al. teach that their adhesive may be used for packaging materials for pharmaceutical products. It has been held that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP 2144.07.

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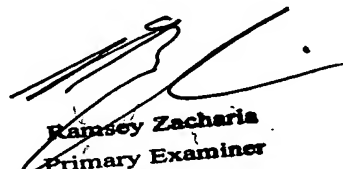
***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518.

The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ramsey Zacharia  
Primary Examiner  
Tech Center 1700